944-005.005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re application of	:	
L. Paatero	:	Examiner: V. Herring
Serial No. 10/090,426	:	Supervisory Examiner: G. Barron
Filed: February 28, 2002	:	Group Art Unit: 2132

For: **METHOD AND SYSTEM TO ALLOW PERFORMANCE OF PERMITTED ACTIVITY WITH RESPECT TO A DEVICE**

Mail Stop Appeal Briefs-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Appellant received an Examiner's Answer dated 9 January 2008. Applicant subsequently received a "corrected" Examiner's Answer dated 3 March 2008, which included a new paragraph at the top of page 4. Applicant is therefore now filing a Reply Brief within two months from 3 March 2008 (as Applicant indicated in Applicant's Communication dated 10 March 2008).

I hereby certify that this paper is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Briefs-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Margery B. Hood — Date: May 5, 2008

REMARKS

The Examiner's Answer states at page four that several grounds of rejection "are not under review on appeal." Applicant would like to respectfully emphasize that page two of the Appeal Brief says: "The rejection of claims 1-27, 35-43, 45, and 47-50 is now being appealed."

If the rejections of the independent claims are overturned on Appeal, then further review of the dependent claims will be unnecessary because they will automatically be allowable. Thus, the Appeal Brief also says at page four that "Applicant is not presenting any of the other dependent claims for review."

Applicant respectfully reiterates what is stated in the Appeal Brief: "the rejection of claims 1-27, 35-43, 45, and 47-50 is now being appealed." The independent claims are 1, 20, 26, 41, and 49.

The "Response to Argument" in the Examiner's Answer is Incorrect

Column 11, line 18 of *Doyle* cites "referenced inventions." The purported incorporation by reference of *Hind* into *Doyle* occurs at column 8, lines 5-15 of *Doyle*, but *Doyle* never directs attention to any specific portions of *Hind*, much less the specific portions of *Hind* that are relied upon at page 16 of the final Office Action to reject Applicant's claim 46 (which has now been inserted into the present independent claims).

The Federal Circuit explained in *Advanced Display v. Kent State*, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000) (emphasis added):

> To incorporate material by reference, the host document must identify with ***detailed particularity what specific material*** it incorporates and clearly indicate where that material is found in the various documents. (emphasis added)

Doyle simply did not do that with regard to the purportedly incorporated *Hind* reference. *Doyle* did not indicate with detailed particularity — or any particularity at all — what

specific material it was incorporating from *Hind*, or where that material can be found in *Hind*.

Applicant therefore respectfully submits that a 102(e) rejection is inappropriate here. The *Doyle* reference does not validly incorporate the *Hind* reference, for purposes of this anticipation rejection under 35 U.S.C. § 102(e), for the reasons explained in *Advanced Display v. Kent State* (quoted above).

The Examiner's Answer does not address *Advanced Display v. Kent State* which was cited in Applicant's Appeal Brief. Instead, the Examiner's Answer simply relies upon 37 CFR § 1.57(b).

Applicant respectfully notes that *Advanced Display v. Kent State* is one of a long line of cases, and the cited principles of *Advanced Display v. Kent State* have since been reaffirmed by the Federal Circuit. For example, in *Zenon Environmental, Inc. v. US Filter Corp*oration (Fed. Cir. 2007), No. 2006-1266, 2006-1267, the court recently restated (original emphasis):

> Incorporation by reference "provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein." Cook Biotech Inc. v. Acell, Inc., 460 F.3d 1365, 1376 (Fed. Cir. 2006) (quoting Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000)). "To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents." Id. (emphases added).

The *Manual of Patent Examining Procedure* — at MPEP § 608.01(p)(I)(A) — says basically the same thing: "Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found." However, *Doyle* does not identify any specific portions of *Hind*.

Without *Hind*, *Doyle* does not teach or suggest the limitations of claim 46 (now in claim 1), nor has the Office pointed to anything in *Doyle* that does so. For these reasons, Applicant respectfully submits that the rejections of the final Office Action have been

shown to be inapplicable, and respectfully requests that the Board reverses the rejections to the pending independent claims 1, 20, 26, 41, and 49.

The Examiner's Answer mentions at page 11 that column 11, lines 35-40 of *Doyle* disclose material that is at page 3, lines 10-11 of Applicant's specification. Applicant traverses this assertion, and in any event this assertion does not address the patentability of the present claims. For example, the Examiner does not contend that column 11, lines 35-40 of *Doyle* anticipate the last two wherein clauses of present claim 1. Instead, the Examiner's Answer relies entirely upon the invalidly incorporates *Hind* reference to reject present claim 1 as well as the other pending claims.

Respectfully submitted,

Date: 5 May 2008

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